

REMARKS

Claim 1 has been canceled, and Claims 2-6 and 8 have been amended. Claims 2-27 are present in the application. In view of the foregoing amendments, and the remarks that follow, Applicants respectfully request reconsideration.

Interview Summary

Following receipt of the Advisory Action mailed on December 18, 2007, the undersigned spoke with Examiner EL-Arini by telephone on January 15, 2008, and reiterated some arguments presented in the remarks of the Response filed on December 4, 2007, relating to problems with the December 4 Office Action. On January 16, 2008, the Examiner telephoned the undersigned, and indicated that she had discussed the matter with her supervisor (Examiner Michael Barr). She said they had decided to withdraw the finality of the December 4 Office Action, and issue a new Office Action. In due course, the present Office Action was issued on May 14, 2008.

Comments Regarding Double-Patenting Rejections

The Office Action rejected Claim 1 of the present application for obviousness-type double patenting, based on Claims 1 and 8 of co-pending U.S. Serial No. 11/251,330 filed October 14, 2005. The foregoing amendments cancel Claim 1, and this double-patenting rejection is therefore moot. Nevertheless, Applicants wish to point out for the record that the double-patenting rejection was not proper, because the copending application no longer includes the two specific claims on which the rejection was based. (Claims 1 and 8 of co-pending U.S. Serial No. 11/251,330 have been canceled).

The Office Action also rejected Claims 1-3 of the present application for obviousness-type double-patenting, based on Claims 1, 2 and 8 of co-pending U.S. Serial No. 11/384,624 filed March 20, 2006. The foregoing amendments cancel Claim 1, and also amend Claims 2 and 3 so that they each now depend from Claim 6. Claim 6 is not subject to any double-patenting

rejection. Accordingly, although Applicants believe there was no merit to the double-patenting rejection based on U.S. Serial No. 11/384,624, that double-patenting rejection is now moot.

Independent Claims 6, 9, 15 and 20

Independent Claims 6, 9, 15 and 20 each stand rejected under 35 U.S.C. §103 as obvious in view of a proposed combination of Hazelton U.S. Patent Application Publication No. 2006/0023185 and three newly-cited references, which are Amblard U.S. Patent No. 7,056,646, Ho U.S. Patent No. 7,070,915, and Asano Japanese Reference No. 2-204468. These grounds of rejection are all respectfully traversed, for the following reasons.

HAZELTON HAS NOT BEEN SHOWN TO BE PRIOR ART

The §103 rejection based on Hazelton fails to properly establish that Hazelton is prior art with respect to the present application. The Examiner asserts on page 5 of the present Office Action that:

With respect to [Applicants' argument that] Hazelton et al. is not prior art, because the filing date of Hazelton is after [the] March 16, 2004 filing date of the present application, Applicants' argument is unpersuasive, because the priority date for Hazelton et al. is April 11, 2003 and June 27, 2003. See 60/462,556 (pages 1-2) and 11/237,651 (2006/0023185) which is a continuation of PCT/US2004/010309.

However, the fact that Hazelton claims the benefit of two priority dates in 2003 does not mean that Hazelton is automatically entitled to the benefit of those priority dates. The Examiner has the burden of establishing a prima facie case of obviousness and, as part of that burden, the Examiner must show not only (1) that Hazelton claims the benefit of priority dates, but also

(2) that Hazelton is legally **entitled** to enjoy the benefit of those priority dates. Here, the Examiner makes showing #1, but not showing #2.

A simple example will help make this point. The Examiner is currently relying **only** on the priority claim to Provisional Application No. 60/462,556 filed April 11, 2003, and **not** on the priority claim to Provisional Application No. 60/482,913 filed June 27, 2003. (This is because, in a prior Office Action mailed on November 15, 2007, the Examiner cited the '556 provisional on Form PTO-892 and provided Applicants with a copy of the '556 application. But the Examiner has never formally cited the '913 provisional application, and has never provided Applicants with a copy of the '913 application). On page 4 of the present Office Action, the Examiner explains the §103 rejection of Claims 6, 9, 15 and 20, and cites certain portions of Hazelton U.S. Patent Application Publication No. 2006/0023185. For example, the Examiner cites and relies on paragraph [0029] of the Hazelton '185 publication. Paragraph [0029] discusses movement of a wafer "W" by an "XY-stage" and a "Z-stage". However, the '556 provisional application has absolutely no mention of an "XY-stage" or a "Z-stage". Consequently, since the subject matter in paragraph [0029] of Hazelton's '185 publication does not appear anywhere in Hazelton's '556 provisional application, the subject matter in paragraph [0029] is **not** entitled to the benefit of the April 11, 2003 filing date of the '556 application, and therefore is **not** "prior art" with respect to the present application. As another example, the §103 rejection on page 4 of the Office Action cites and relies on Figures 1 and 10 of Hazelton's '185 publication. However, the '556 provisional application does not have any figures that are similar to Figures 1 and 10 of the '185 publication. Consequently, since the subject matter in Figures 1 and 10 of Hazelton's '185 publication does not appear anywhere in Hazelton's '556 provisional application, the subject matter in Figures 1 and 10 is **not** entitled to the benefit of the April 11, 2003 filing date of the '556 application, and therefore is **not** "prior art" with respect to the present application. As yet another example, the §103 rejection on page 4 of the Office Action asserts that the Hazelton '185 publication discloses "a system of cleaning a wafer". In contrast, the '556

provisional application teaches how to extract fluid from a lens, but has absolutely no teachings whatsoever about cleaning a wafer. Consequently, the discussion in Hazelton's '185 publication about cleaning a wafer is **not** entitled to the benefit of the April 11, 2003 filing date of the '556 application, and is therefore not "prior art" with respect to the present application. Even though Hazelton **claims** the benefit of the '556 provisional, Hazelton is not **entitled** to the priority of the '556 provisional as to subject matter that is not disclosed in the '556 provisional. **If subject matter is not in Hazelton's '556 provisional application, then it is not prior art with respect to the present application. In the §103 rejection, the Examiner should start by showing where subject matter is disclosed in the '556 provisional application.** But even showing that subject matter is in the '556 provisional is not enough. There are other separate and distinct reasons why the Examiner has failed to show that Hazelton is actually **entitled** to the benefit of the 2003 filing date of the '556 provisional application.

In more detail, the Hazelton '185 publication is a publication of a U.S. application that was filed on September 29, 2005, but this filing date is after the March 16, 2004 filing date of the present application. The Hazelton '185 publication claims the priority of a PCT application filed on April 2, 2004, but the PCT filing date is also after the March 16, 2004 filing date of the present application. Through the PCT application, Hazelton claims the priority of two U.S. provisional applications but, as discussed above, the Examiner is currently relying on only one of those two provisional applications (U.S. Provisional Application No. 60/462,556 filed April 11, 2003). In order to be applied under §103, Hazelton must qualify as prior art under one of the subsections in §102. Apparently, the Examiner is relying on §102(e). In order to show that Hazelton is prior art under §102(e), the Examiner will need to show that various requirements have been met.

First, §102(e) specifies that a PCT application can only be prior art if it "designated the United States and was published under Article 21(2) of such [PCT] treaty in the English language". Thus, as to the PCT application, the Examiner will need to demonstrate (1) that it designated the United States, (2) that it was in fact published by the World Intellectual Property

Organization (WIPO), and (3) that the publication occurred in the English language. So far, the Examiner has failed to make any of these three required showings. The present Office Action is accompanied by a partial copy of the PCT application, but that copy is not complete. (For example, it does not include the claims of the PCT application). Moreover, the partial copy is not from a **published** version of the PCT application, and does not contain anything showing (1) that the PCT application was published, (2) that it was published in English, or (3) that it designated the United States.

Further, as to **each** teaching for which Hazelton is cited, the Examiner will need to show (1) where that teaching is disclosed in Hazelton's '556 provisional application, (2) where that teaching is disclosed in Hazelton's PCT application, and (3) where that teaching is disclosed in Hazelton's U.S. Patent Application Publication No. 2006/0023185. Otherwise, the teaching does not qualify as prior art with respect to the present application. The Examiner has failed to do this. To the contrary, as discussed above, the Examiner's §103 rejection cites and relies on portions of the '185 publication that are clearly **not** present in the '556 application, and that are therefore **not** prior art.

The Examiner seems to have (1) the misimpression that Hazelton's '185 publication is **automatically** entitled to all of its claimed priority dates, and (2) the misimpression that **everything** disclosed in the Hazelton '185 publication is entitled to the benefit of the claimed priority dates. However, these misimpressions are not correct. For example, the attention of the Examiner is respectfully directed to MPEP §2136.03(II) and §2136.02(III), including the discussion there of the first paragraph of 35 U.S.C. §112.

In the present application, the Examiner has the burden of proving several points that are all necessary to establish that teachings in Hazelton are "prior art" with respect to the present application. But to date, the Examiner has failed to make all the necessary showings. Absent those showings, the Examiner has not carried the burden of proving that those teachings qualify as prior art with respect to the present application, and has therefore failed to properly establish a

prima facie case of obviousness. As a result, the §103 rejections of Claims 6, 9, 15 and 20 based on Hazelton are each automatically defective.

THE BASIS FOR THE REJECTION IS NOT CLEAR

MPEP §706.02(j) explains that, in order to establish a prima facie case of obviousness as to any given claim under §103, an examiner must satisfy four specific requirements. In particular, MPEP §706.02(j) specifies that:

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

On page 4 of the present Office Action, the Examiner makes a sweeping rejection of more than 25 claims based on Hazelton, Amblard, Ho and Asano, while offering only a few short words of explanation. The explanation is not even remotely enough. It does not clearly show which references are being applied against which claims, or exactly how the references are being

applied against each claim. More specifically, the Examiner fails to make, for **each claim**, the **required** showing of **each** of items (A), (B), (C) and (D) above. Instead, for example, as to item (B), the Examiner makes only a single assertion that "Hazelton et al. do not teach the surfactant, and means for providing surfactant, and the second fluid comprises NH₄OH, and H₂O₂". This assertion is not even remotely sufficient to support 25 grounds of rejection for 25 different claims. Similarly, as to item (D), the Examiner makes only a single assertion that "[it] would have been obvious to one skilled in the art to replace the ethanol of Hazelton et al. with the surfactant of Amblard et al. or JP '486, because both ethanol and surfactant have strong affinity to water". This statement is not even remotely sufficient to support 25 grounds of rejection for 25 different claims. Moreover, this statement mentions only Hazelton, Amblard and Asano, and fails to explain why a person of ordinary skill would be motivated to make a modification to Hazelton in view of the **Ho reference**. The confusion is further complicated by the fact that, as discussed earlier, the primary reference in the §103 rejection is Hazelton, but the Examiner cites and relies on teachings that are clearly **not** prior art with respect to the present application (because those teachings do not appear anywhere in Hazelton's '556 provisional application). As pointed out in MPEP §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Accordingly, for each of the different reasons discussed above, it is respectfully submitted that the Examiner has failed to properly establish a *prima facie* case of obviousness as to any of Claims 6, 9, 15 and 20 of the present application. Accordingly, in view of the lack of a *prima facie* case of obviousness, it is respectfully submitted that Claims 6, 9, 15 and 20 are all allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 2-5 and 7-8, Claims 10-14, Claims 16-19 and Claims 21-27 respectively depend from Claim 6, Claim 9, Claim 15 and Claim 20, and are also believed to be allowable over the art of record, for example for the same reasons discussed above in association with Claims 6, 9, 15 and 20.

Conclusion

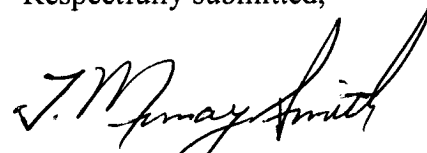
Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

Appl. No. 10/802,087
Reply to Office Action of May 14, 2008

Attorney Docket No. 2003-1435 / 24061.911
Customer No. 42717

Although Applicants believe that no additional fees are due, the Commissioner is hereby authorized to charge any fees required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone, LLP.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "T. Murray Smith", with a stylized flourish at the end.

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Enclosures: None

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